

## **REMARKS**

Claims 1-3, 5-7, 10, 12, and 14-20 are presently pending for the Examiner's review and consideration. Claim 1 has been amended and new claims 14-20 have been added. The new claims are all fully supported by the originally filed specification, drawings, and claims of the application. With reference to the published application (US 2003/0115829A1), claims 14-16 are supported, for example, in paragraph [0007]; claim 17 is supported, for example, in paragraph [0005]; claim 18 is supported, for example, in the previous version of claim 1; claim 19 is supported, for example, in paragraph [0008]; and claim 20 is supported, for example, in the originally filed claims and several of the above-cited paragraphs.

In the Final Office Action, claims 1-3, 5-7, 10, and 12 were rejected under 35 U.S.C. § 103(a) as obvious over Greenway in view of Taylor and Searer. The Supplemental Declaration under 37 C.F.R. § 1.132 of Richard Hirsch (the "Supp. Hirsch Declaration") submitted herewith, supplements his previous declaration of July 2, 2004, and supports the non-obviousness of the present claims over the references.

Independent claims 1 and 20 recite methods of attaching solid hardwood floor planks to a concrete surface, in which a water resistant and impermeable and/or moisture curable adhesive is applied to attached the floorboards to the surface. Additionally, the boards are nailed to the concrete floor surface, and the adhesive allowed to set. Claim 20 specifies that the nails are used to hold the boards to the surface as the adhesive sets. Independent claim 5 structurally defines a floor that has a concrete surface with solid plank wood floorboards thereattached with a water resistant and impermeable adhesive, but with no subflooring between the boards and the concrete floor surface. Additionally, nails extend through the boards and the adhesive into the concrete floor surface.

### **The References**

As Mr. Hirsch explains in his declaration, prior to the present invention, wood flooring needed to be very flat if adhesive were used to attach wood flooring directly to concrete to ensure proper and sufficient contact between the floorboards, adhesive, and the concrete. This significantly limits the type of preparation of the wood that can be used prior to the floor installation, as some types of preparations cause the wood boards to warp significantly, to an extent that it would not be possible to obtain a strong, complete adhesion

between the concrete surface and the floorboards laid by traditional methods. (Supp. Hirsch Declaration, ¶ 4.)

Another problem that occurs with floorboards that are attached directly to a concrete floor surface is that water can collect on the concrete surface and may not drain away from the floorboards since floors are typically generally horizontal. The trapped water on the concrete below is absorbed into the wooden floorboards, which can produce a highly elevated hydrostatic pressure in the floorboards. In turn, the elevated hydrostatic pressure causes the floorboards to warp powerfully, which is more than sufficient to cause the wood to peel away from the concrete when installed with traditional methods, ruining the floor. Very strong adhesives that can resist this warping and water are needed to retain the attachment of the floorboards to the concrete. If the adhesive cannot withstand this water and its effects on the wood floorboards, then the trapped water can also destroy the adhesive bond between the wood and the concrete surface. (Supp. Hirsch Declaration ¶ 5.)

Greenway teaches using mastic to attach floorboards to concrete. The mastic material would not have withstood the hydrostatic pressure or any water-logging on the concrete, because mastics are water permeable and are not water resistant. As Mr. Hirsch declares, mastics would not have provided a strong enough adhesion to prevent warping and buckling away from the concrete surface. Additionally, Greenway does not use or foresee any need for using nails with the floorboards and the mastic, since the mastic is taught as being sufficient to attach the floorboards. (Supp. Hirsch Declaration ¶ 7.)

On the other hand, the Searer teaching is directly contradictory to Greenway. Searer provides as a "primary object of the invention . . . to provide interlocking floor . . . covering members . . . , whereby the covering members may be attached to the appropriate surface without the use of adhesives and . . ." (Searer 2:21-30 (emphasis added).) Searer seeks to avoid aeration and other treatments that are used with adhesives, as well as eliminating the use of gloves or masks that are employed by individuals laying the floor surface. (E.g., Searer 1:16-24.) As supported by Mr. Hirsch's declaration, one of ordinary skill in the art would view Searer as expressly intending to avoid using adhesives and any problems that are caused thereby, such as the toxic or harmful chemical substances that are contained in adhesives, and it is Mr. Hirsch's opinion that one of ordinary skill in the art would find that "the use of any adhesive in attaching floorboards is expressly contrary and repulsive to the teaching of Searer." (Supp. Hirsch Declaration ¶ 8.)

In Mr. Hirsch's opinion the Greenway teaching of using mastic cannot be reconciled with Searer's teaching of not using any adhesive, because this would be directly

contrary to Searer's explicit teaching. (Supp. Hirsch Declaration ¶ 15.) It is well known that "[i]t is improper to combine references where the references teach away from their combination." (MPEP § 2145(X)(D)(2).) Additionally, one cannot merely pick and choose isolated bits and pieces of the prior art to arrive at the claimed combination in hindsight, since the "totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of non-obviousness." (MPEP § 2146(X)(D)(3).) Thus, the nails of Searer cannot merely be selected to combine with the teaching of Greenway, since the totality of the Searer teaching explicitly has much to say about avoiding the use of any adhesives. Thus Searer and Greenway are not properly combinable in this rejection, and there is no motivation to make such a combination, since it is contrary to the accepted wisdom in the art, as evinced by the totality of the disclosures of these two references.

With respect to the Taylor patent, Taylor discloses using an adhesive and nails to attach drywall to vertical wall studs. As declared by Mr. Hirsch, installing floorboards directly on concrete involves very different problems to be overcome that in attaching drywall to wall studs, and vice versa. (Supp. Hirsch Declaration ¶ 9.) For example, drywall is not susceptible to hydrostatic pressure in the manner that wooden floorboards are, with no similar extremely powerful warping occurring that could peel drywall away from the studs with anywhere near the same force as wooden floorboards would exert from the surface to which they are attached. In fact, Mr. Hirsch explains that if moisture were absorbed in drywall, it would most likely be ruined, and another piece of drywall would need to replace it. In Mr. Hirsch's opinion, there is thus no motivation to try to save the adhesion of a water-logged piece of drywall. (Supp. Hirsch Declaration ¶ 10.)

Moreover, the problem of water-logging is not present in walls as it is in floors, since the walls are basically vertical. On horizontal floors, moisture can collect adjacent an extremely large portion of the wood flooring surface, and can even cause the flooring to become submerged. This is highly unlikely with a wall, which is vertical and does not collect water. Furthermore, the narrow studs of Taylor are separated by a large amount of porous insulation, and there is no mechanism that could possibly collect the water and hold it against the drywall as would be the case with the water held in contact with the floorboards by a concrete subflooring. (Supp. Hirsch Declaration ¶ 11.) With respect to the manufacturing processes that can produce warped floorboards that would traditionally have been unusable for adhesion to concrete, but which are usable with the present invention, drywall is manufactured in very regular and flat sheets, and there is no curing-induced

warping of the drywall prior to beginning the installation thereof, as there may be in wood floorboards. (Supp. Hirsch Declaration ¶ 12.)

The Examiner had argued that one of ordinary skill in the art would have used the nails and adhesives in Taylor and applied it with both the teachings of using mastic of Greenway and the teaching of Searer, which uses nails, but specifically avoids adhesives. The reasons for using nails in the Taylor disclosure, however, have no application to laying flooring. Mr. Hirsch explains that since the Taylor drywall is adhered to the studs in a vertical position, the drywall would naturally tend to fall away from those studs before the adhesive sets, and thus, the nails are needed to hold the drywall in a vertical position against gravity. On the other hand, gravity is beneficial in holding flooring against subflooring and clearly would not tend to peel the flooring away from the subflooring. It is Mr. Hirsch's opinion that the Taylor reference does not provide any suggestion that using the nails in addition to adhesives would be helpful when installing flooring, since the purpose of the nails in Taylor is to resist gravity, which is not applicable when installing flooring. (Supp. Hirsch Declaration ¶ 13.) The problems resolved by the Taylor reference are not analogous to the problems solved by the invention of the present claims, and one of ordinary skill in the art would not have looked to the Taylor reference to resolve the problems associated with installing wooden floorboards on a concrete surface. For example, warping due to pre-installation preparation of the wood or hydrostatic pressure are not problems that exist in the field that the Taylor patent is concerned with, as explained above. (Supp. Hirsch Declaration ¶ 14.)

Additionally, there is no motivation to look to the drywall installation of Taylor to combine it with teachings of flooring installation, since the problems present and resolved in Taylor are completely unrelated to flooring installation. (Supp. Hirsch Declaration ¶ 15.) The combination of the three references can only be made using impermissible hindsight by picking and choosing features of the different references based on the present claims, but without the required suggestion or motivation to combine those features in the manner argued in the office action and while additionally ignoring specific teachings that would prevent such combination. Additionally, it is Mr. Hirsch's opinion that no combination of the teachings would have produced the inventions of any of the claims, including the independent claims 1, 5, and 20, since there is no cumulative teaching of using a water resistant and impermeable and/or moisture curable adhesive in addition to nails to attached wooden floor panels to a concrete surface. The mastic of Greenway, for example, would not resist the problems encountered with a water laden subflooring. The Searer

teaching is specifically free of adhesives, and the Taylor teaching does not suggest using an adhesive and nailing for installing wood boards to concrete to provide flooring. (Supp. Hirsch Declaration ¶ 16.)

Mr. Hirsch also opines that the advantages provided by the inventions of claims 1, 5, and 20 and the dependent claims are surprising in view of any combination of the references. Specifically, using nails in addition to adhesives can keep the floorboards in proper contact with the adhesive, and keep the adhesive in proper contact with the concrete surface while the adhesive cures. This greatly improves the resistance to warping of the wood and the accompanying wood movement that can occur due to hydrostatic pressure. Greenway does not provide any suggestion that such warping is a problem, and instead resorts to a non-water resistant mastic and flat floorboards. Searer teaches that no adhesive should be used, and Taylor's installation of drywall does not foresee any of the warping problems associated with wooden floorboards. (Supp. Hirsch Declaration ¶ 17.) Thus, claims 1, 5, and 20 are not obvious over the references. The Declaration submitted under Rule 132 of Joseph Grady, signed April 29, 2004, further supports the patentability of these claims, and is presently brought to the Examiner's attention.

Additionally, claims 14 and 15 specifically recite adhesive compositions that have been found to be especially reliable in the environment of wooden floorboards laid on concrete, and the moisture curability of the preferred adhesive, which is also recited in claim 20, additionally provides surprising advantages since the adhesive can cure even though moisture is present. The recitation of claim 19, that the adhesive sets after the floorboards are nailed, specifically highlights the surprising advantage provided by the nails in retaining proper contact with the floorboards, adhesive, and the concrete surface while the adhesive cures. As explained above, this is especially beneficial, for instance, when the hydrostatic pressure in floorboards becomes elevated. (Supp. Hirsch Declaration ¶ 6.)

Additionally, claim 17 defines that the nails are hidden in wormholes and/or scratches in the wood. This is clearly neither taught nor disclosed in any of the references and provides the surprising advantage that the hiding of the nails can be achieved by taking advantage of features that can make newly installed floorboards look like they are actually aged. (Supp. Hirsch Declaration ¶ 21.)

### **Secondary Considerations**

The U.S. Supreme Court has established that secondary considerations of non-obviousness must be considered during the examination of claims. As stated in the MPEP,

the U.S. Patent & Trademark Office, in following the U.S. Supreme Courts decisions, requires factual inquiries into the background for determining obviousness, which includes evaluating evidence of secondary considerations. One of the secondary considerations, or objective evidence, which must be considered is the commercial success enjoyed by the product, as well as evidence of unexpected results, long felt need, and failure of others. These secondary considerations "must be considered in every case in which they are present[, and when] evidence of any of these secondary considerations is submitted, the Examiner must evaluate the evidence." (MPEP § 2141 (emphasis added).) The ultimate determination of patentability is thus made on the entire record. (*Id.*)

As was highlighted in the previous Response to the Final Office Action, which was submitted on January 13, 2005, the Applicant brought to the attention of the Examiner that evidence of outstanding commercial success of the product constructed according to the claims had been presented in the previous Declaration Under Rule 132 by Mr. Hirsch, which was signed on July 6, 2004, and that this evidence had not been considered by the Examiner. Once again, with the present Advisory Action, the Examiner has completely ignored this evidence of commercial success and the highlighting thereof by the Applicant. The Examiner is reminded that the Applicants do not have to prove that the commercial success is not due to other factors. (MPEP § 716.03(b).) On the contrary, Applicant's submission of the evidence of commercial success of the claimed product and of the product obtained by the claimed methods in each of the claims, satisfies the burden of proof of establishing nexus between the claimed invention and the commercial success. (*See* MPEP § 716.03.) The Examiner is once again requested to fulfill his duty in considering this evidence.

The Supplemental Declaration of Mr. Hirsch provides more objective evidence that qualifies as secondary considerations. Evidence is submitted that experts in the art of floor installation have expressed surprise at the results obtained from installing flooring, as defined at least in the independent claims.

In support of this opinion of Mr. Hirsch, he submits Exhibit A, which is a letter from a company whose principle business is to install floors. To the best of Mr. Hirsch's knowledge, the process used to install the floors was approved by the Assignee of the present application, and corresponded to claims 1, 14-16, and 18-20, producing a flooring as recited in claim 5. (Supp. Hirsch Declaration ¶ 18.) After water from a strong storm leaked into the model home in which the floor had been laid, the floor was torn up by a professional demolition team. The demolition team expected to easily tear up the damaged area, since it should have normally taken less than eight hours for that team using the type of

floor stripper that is described, but instead, the team took two days to remove the floor and moreover broke two of the industrial floor strippers in the process. These strippers are normally expected to last for many floor removals. Thus, the team took far longer than expected, and the strippers failed long before expected. (Supp. Hirsch Declaration ¶ 19.)

Pictures of a scrap of the torn-up floor are provided in Exhibit B with a half inch of concrete still attached. The author of the letter expressed surprise at the results, and is emphatic about the chunk of concrete still attached to the wood scrap. As evinced by Mr. Hirsch's supplemental declaration, these results were surprising to one of ordinary skill in the art of wood flooring installation, as the adhesive and the wood itself would have been expected to fail long before the concrete when the flooring was stripped, instead of pulling up chunks of concrete. This evidence thus establishes that the results obtained by the claimed method are unexpected, showing skepticism of experts and the failure of others to obtain such results, since the installation was far stronger and more reliable than previous methods. (Supp. Hirsch Declaration ¶ 20.)

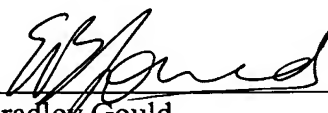
For these reasons as well, claims 1, 14-16, and 18-20 are also patentably distinct over the references.

### **Conclusion**

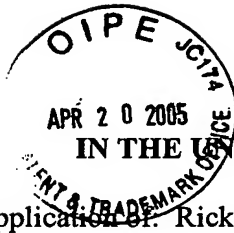
For these reasons, the entire application is now believed to be in condition for allowance. Should any issues remain, a personal or telephone interview is respectfully requested to expedite the allowance of the application.

Respectfully submitted,

April 20, 2005  
Date

  
E. Bradley Gould (Reg. No. 41,792)  
For: Allan A. Fanucci (Reg. No. 30,256)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rick K. SOUTHERN et al.

Application No.: 10/034,446

Filed: December 26, 2001

For: METHODS FOR ATTACHING SOLID  
HARDWOOD FLOOR PLANKS TO  
CONCRETE FLOOR SURFACES

Confirmation No.: 1727

Group Art Unit: 3637

Examiner: Phi Dieu Tran A

Attorney Docket No.: 104981-4000

**SUPPLEMENTAL DECLARATION UNDER  
37 C.F.R. § 1.132 OF RICHARD HIRSCH**

Assistant Commissioner of Patents  
Washington, DC 20231

Sir:

1. My present Declaration supplements my Declaration signed on July 2, 2004. I hereby incorporate by reference my statements from the July 2, 2004 Declaration.

2. I have reviewed and understand the above identified application, the pending claims, the final Office Action mailed on October 20, 2004, the Amendment filed on January 13, 2005, the Advisory Action mailed on February 7, 2005, the Amendment submitted concurrently herewith, as well as the references cited in the final Office Action, specifically U.S. Patent No. 2,088,238 to Greenway ("Greenway"), No. 3,740,910 to Taylor et al. ("Taylor"), and No. 5,570,554 to Searer ("Searer"). I am making the following statements as one of ordinary skill in the art in support of patentability of the claims in this application.

3. Claims 1 and 20 of the present application recite methods of attaching solid hardwood floor planks to a concrete surface. The floor planks are applied to the concrete floor surface with a water resistant adhesive that attaches the floorboards to the surface. Claim 1 defines the adhesive as water-impermeable, and claim 20 defines the adhesive as water curable. Then, the floorboards are nailed to the concrete surface. The adhesive is then allowed to set. Claim 5 structurally defines a floor with the wood



floorboards attached to the concrete floor surface by both an adhesive and nails, which extend through the board and the adhesive into the concrete floor surface.

4. Prior to this invention, to use any type of adhesive to attach wood flooring directly to concrete, the wood flooring needed to be very flat to ensure proper and sufficient contact between the floorboards, adhesive, and concrete. This limits the type of preparation of the wood that can be conducted prior to the adhering. In certain types of wood flooring preparation, especially in certain types that are conducted away from the installation site due to the machines and processes used (see claim 15) the wood boards end up significantly warped to an extent that it can be very difficult or impossible to obtain a strong or complete adhesion to the concrete surface when the floorboards are laid thereon.

5. A problem that is present when floorboards are attached directly to a concrete floor surface is that water can collect on the concrete surface and may not drain away from the floorboards. This is a problem that exists in flooring installation, since the floor is generally horizontal, but this problem is not present in wall installations, where water will drain away from the wall due to the vertical orientation thereof, even if the surface behind the wall can serve to trap water. The water trapped on the concrete below the floor panels is then absorbed into the wooden floorboards, and this can produce very elevated hydrostatic pressures in the floorboards. The elevated hydrostatic pressure causes the floorboards to warp powerfully, which is more than sufficient to cause the wood to peel away from the concrete, ruining the floor. The warping causes the floorboards to lift off the concrete surface with such force that very strong adhesives are needed to retain the attachment of the floorboards to the concrete. In addition, if the adhesives are not water resistant, and preferably impermeable, then the trapped water can also destroy the adhesive bond between the wood and the concrete surface.

6. Both the use of the water resistant and water impermeable and/or curable adhesive and of the nailing that are recited respectively in claims 1, 5, 13, and 20 provide the surprising advantages over the prior art. The water resistant, and preferably impermeable, adhesive can withstand or prevent the pooling of water on the concrete

surface, and the nails hold the wood floorboards against the adhesive and concrete surface to improve resistance to the warping due to elevated hydrostatic pressure. Claims 13 and 14 specifically recite adhesive compositions that we have found to be especially reliable in this environment, especially since these are moisture-curable, as also defined in claim 20, so they can still cure when moisture is present. Claim 18 recites that the adhesive sets after the floorboards are nailed, which specifically highlights the surprising advantage provided by the nails in retaining proper contact of the floorboards, adhesive, and concrete surface while the adhesive is curing, which is especially beneficial, for instance, when the hydrostatic pressure in the floorboards becomes elevated.

7. While Greenway teaches using a mastic to attach floorboards to a concrete subflooring, this material would not have withstood hydrostatic pressure or any waterlogging on the concrete since mastics are water permeable and not water resistant and would not have provided a strong enough adhesion to prevent warping and buckling away from the concrete surface.

8. Contrary to Greenway, the "primary object of the invention" of Searer "is to provide interlocking floor ... covering members ..., whereby the covering members may be attached to the appropriate surface without the use of adhesives ...." (Searer 2:21-30 (emphasis added).) Searer explains that its invention seeks to avoid aeration and other treatments that are used with adhesives and also seeks to eliminate the use of gloves or masks that are employed by individuals laying the floor surface. (*E.g.*, Searer 1:16-24.) Since Searer expressly intends to avoid using adhesives and any problems that can be caused by chemical adhesives that can contain toxic or harmful chemical substances, it is my opinion that one of ordinary skill in the art would find that the use of any adhesive in attaching floorboards is expressly contrary and repulsive to the teaching of Searer. It is thus my opinion that Searer specifically teaches people of ordinary skill in the art that no adhesives should be used with its invention.

9. The Taylor disclosure is directed to a method of attaching drywall in a vertical orientation to wooden wall-studs. Installing floorboard directly on concrete

involves very different problems to be overcome than in attaching drywall to wall studs, and vice versa.

10. Notably, drywall is not susceptible to hydrostatic pressure in the same manner as wooden floorboards. While certain types of drywall may absorb moisture, there is no extremely powerful warping that could peel it with anywhere near the same force away from the surface to which is attached as is the case with wooden floorboards. In fact, if moisture is absorbed, the drywall most likely will be ruined, and another piece would have to be used, so it is my opinion that there is no motivation to try to save the adhesion of a waterlogged piece of drywall.

11. Additionally, the problem of water-logging is not present in walls as it is in floors since the walls are basically vertical, while the concrete surface below floorboards can collect moisture adjacent an extremely large portion of the wood flooring surface and can even cause the flooring to become submerged. Furthermore, the narrow studs of Taylor are separated by a large amount of porous insulation, and there is no mechanism that could possibly collect the water and hold it against the drywall as would be the case with the water held in contact with floorboards by a concrete subflooring.

12. Finally, drywall is manufactured in very regular and flat sheets, and other problems encountered with treatments of floorboards that can cause them to become uneven or warped when cured is not present in drywall.

13. While Taylor discloses using an adhesive and nails to attach the drywall to the vertical wall-studs, this is done for reasons that have no application in laying flooring. Since the drywall is adhered to the studs in a vertical position, the drywall would naturally tend to fall away from the studs before the adhesive sets. The nails are needed because the drywall is held in a vertical position. On the other hand, when constructing flooring, gravity is beneficial in holding the flooring against the subflooring and does not, instead, act to peel the flooring away from the subflooring. Consequently, it is my opinion that the Taylor reference does not provide any suggestion that using the nails in addition to adhesives would be helpful when installing flooring,

since the purpose of the nails of Taylor is to resist gravity, which is not applicable when installing flooring.

14. Consequently, the problems resolved by the Taylor reference are not analogous to the problems present in installing wooden floorboards on a concrete surface, which can be resolved using the present invention. Further, it is my opinion that one of ordinary skill in the art would not look to the Taylor reference to resolve the problems associated with installing the wooden floorboards on a concrete surface, such as warped shapes due to the preparation of the wood, or hydrostatic pressure peeling the wood away from the concrete due to water collected by the concrete in contact with the adhesive and floorboards.

15. It is my opinion that one of ordinary skill in the art would not find any suggestion or motivation to combine Greenway, Searer, and Taylor to provide the claimed invention. This is because, for example, Greenway's use of mastic cannot be combined with Searer's teaching of not using any adhesive, and Taylor and the problems it solves are completely unrelated to flooring installation.

16. Furthermore, it is my opinion that no combination of these teachings would produce the inventions of the above-mentioned claims since there is no cumulative teaching of using a water resistant and impermeable and/or moisture-curable adhesive in addition to nails to attach wooden floor panels to a concrete surface (which is generally horizontal in a floor). For instance, the mastic of Greenway would not resist the problems encountered with a water-laden subflooring, the Searer teaching cannot be combined with using an adhesive, and the teaching of Taylor does not suggest both adhering and nailing wooden boards to concrete to provide a flooring.

17. It is additionally my opinion that the advantages provided by the inventions of claims 1, 5, and 20 and the claims dependent thereon are surprising in light of any possible combination of the references. Specifically, providing nails in addition to the adhesives can keep the floorboards in proper contact with the adhesive, and the adhesive in proper contact with the concrete surface while the adhesive cures, greatly

improving resistance to warping of the wood that can be encountered and wood movement due to hydrostatic pressure. This is surprising in view of the references. For example, Greenway does not provide any suggestion that such warping is a problem and instead resorts to non water-resistant mastic and using flat floorboards. Searer teaches that no adhesive should be used. Taylor's installation of drywall in a vertical orientation does not present the problems of warping as would be found in wooden floorboards.

18. In addition, even experts in the art of floor installation have expressed surprise at the results obtained from installing flooring as defined in many of the claims. Attached as Exhibit A is a letter dated October 8, 2003 from Joseph Baugher from Accent Flooring, which is a company whose principal business is to install floors. This letter was previously submitted as Exhibit C in my previous Declaration Under Rule 132 signed on October 28, 2003. As explained in the letter, in November 2002, Accent Flooring installed 1,150 square feet of wooden floorboards from the Assignee's product line sold under the mark Olde Boards®. The Assignee's policy is to only sell Olde Boards® flooring to buyers who (a) agree to install the flooring using a prescribed installation process, and (b) use installers that the Assignee has trained and certified to ensure that the prescribed process is used. The process that we require to be used, and which to the best of my knowledge was used by Accent Flooring, corresponds to a method and produces a flooring are recited at least in the independent claims 1, 5, and 20, as well as dependent claims including but not limited to claims 14-16, and 18-20.

19. Mr. Baugher's letter indicates that water from a strong storm leaked into the model home in which the floor had been laid, leaving a puddle of water under the newly laid floor. The floors were torn up because the home was to be shown soon and the parties did not want to wait for the floors to dry so that any cupping would go down. When a demolition team came to tear up the installed floors, they expected to easily tear up the damaged area. Instead, the team took two days to remove the floor and broke two industrial floor stripper machines in the process. The industrial floor strippers that were used were Sinclair Turbo Strippers. In my estimation, the normal amount of time for three men to tear up 1,150 square feet of flooring laid by traditional methods would have been less than about 8 hours using these strippers, which are expected to last for many

such uses. Thus, the team took far longer than expected, and the stripers failed long before expected

20. This letter was mailed on October 6, 2003 to the Assignee of the present application. Attached to the letter is notarization of Mr. Baugher's signature. The letter was also received along with the referenced scrap of the torn up floor with 1/2-inch concrete still attached. Mr. Baugher's surprise is also evident from the last sentence in his letter, in which he mentions this scrap still has a 1/2" of concrete on it, concluding this sentence with an exclamation point. A photograph showing the scrap with the concrete still attached as received with the letter is submitted herewith as Exhibit B. This is also a surprising result compared to the prior art since with typical installations of wood flooring, the adhesive and wood itself would have been expected to fail long before the concrete when the flooring was stripped. In conclusion, it is my opinion that people having ordinary skill in the art would certainly find that the claimed adhering and nailing of the wood floors to a concrete surface provide surprising advantages in that the attachment is much stronger and far more reliable than possible with previous methods.

21. Claim 16 defines that the nails are hidden in wormholes and/or scratches. This is also not taught or disclosed in the references, and provides the surprising advantage that newly installed floorboards can be made to look aged and can appear to have been installed without nails, since these are hidden in surface features.

22. I further declare that all statements made herein of my knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon

Dated this 29 day of March, 2005.

Declarant:

Richard Hirsch  
Richard Hirsch

# Best Available Copy

## Exhibit A

### *Accent Flooring*

P.O. Box 972  
Orland, CA 95963  
(530) 865-6411

Joseph (Jody) Baugher  
Owner/Contractor  
License #780798

October 6, 2003

*Olde Boards*  
Richard - Marshall, Inc.  
12520 Wilkie Avenue  
Hawthorne, CA 90250  
(800) 689-5981

Dear Richard or whom it may concern,

In November of 2002, while installing a 1,150 square foot Olde Boards job at William Lyons Homes in Hercules, Ca, a very strong storm with hard rains and gale force winds hit. Around 5:00pm we noticed water squirting up between freshly installed boards in the living room. Upon inspection we found four leaks in the new \$900,000 model home and a very large and growing puddle of water under the newly laid floor.

The next day I phoned Rick Southern at Olde Boards and under his suggestion I tried to tear up some boards that were saturated with water and none of them would move. Olde Boards adhesive was used for the install and I later discovered that I used a trowel that was much smaller than recommended on the adhesive container to apply the adhesive. The adhesive had set up overnight while sitting in a literal puddle of water.

A demolition team from Campbell's Carpets came in to tear up about 180 square feet of cupped boards as Lyon Homes did not want to wait for cupping to go down to show the model home. The demolition team said that they could easily tear up the damaged area with a Sinclair Turbo Stripper, but in the process they broke two of them, and it took three men two days to do the job.

Enclosed is a scrap of the torn up floor with 1/2" concrete still on it!

Sincerely,



Joseph R. Baugher  
Accent Flooring

## CALIFORNIA ALL-PURPOSE ACKNOWLEDGEMENT

STATE OF California )  
COUNTY OF Monterey )

File No:  
APN No:

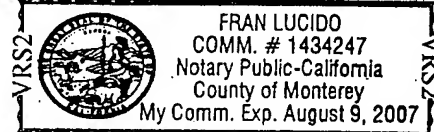
On October 7, 2003 before me, Fran Lucido personally appeared Joseph R. Baugher

~~personally known to me~~ (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies) and that by his/her/their signature(s) on the instrument the person(s) or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

Signature

*Fran Lucido*



This area for official notarial seal.

### OPTIONAL SECTION CAPACITY CLAIMED BY SIGNER

Though statute does not require the Notary to fill in the data below, doing so may prove invaluable to persons relying on the documents.

- ☒ INDIVIDUAL
- ☐ CORPORATE OFFICER(S) TITLE(S)
- ☐ PARTNER(S) ☐ LIMITED ☐ GENERAL
- ☐ ATTORNEY-IN-FACT
- ☐ TRUSTEE(S)
- ☐ GUARDIAN/CONSERVATOR
- ☐ OTHER

SIGNER IS REPRESENTING:

Joseph R. Baugher  
Name of Person or Entity

\_\_\_\_\_  
Name of Person or Entity

### OPTIONAL SECTION

Though the data requested here is not required by law, it could prevent fraudulent reattachment of this form.

### THIS CERTIFICATE MUST BE ATTACHED TO THE DOCUMENT DESCRIBED BELOW

TITLE OR TYPE OF DOCUMENT: Letter from Accent Floor Inc. to Olde-Boards / Richard-Marshall Inc.

NUMBER OF PAGES 1 DATE OF DOCUMENT October 6, 2003

SIGNER(S) OTHER THAN NAMED ABOVE *Fran Lucido*

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